

REMARKS

The application has been amended to correct the cited informalities, distinguish the claimed invention over the cited prior art, and to place the application, as a whole, into *prima facie* condition for allowance. Care has been taken to avoid the introduction of any new subject matter into the application as a result of the foregoing amendments.

The disclosure has been objected to on the basis of the following informality: "In line 2 of the substitute paragraph 0001 of the specification, the term "allow" should be replaced with the term – alloy – to correct a minor typographical error. In complete response thereto, Applicant has submitted a replacement paragraph [0001] in which "allow" has been replaced with – alloy --. Accordingly, Applicant submits that the Examiner's basis for objection to the disclosure should be deemed overcome, and reconsideration and withdrawal of the objection to the disclosure are respectfully solicited.

Claim 1 has been objected to because of the following informality: "The phrase 'single-part' should be replaced with the phrase – single part – for grammatical clarity." In response thereto, applicant has amended the claim to remove the expression "single-part" in its entirety, replacing it with the expression "monolithically formed together" which Applicant submits is precise, clear and definite. Accordingly, Applicant submits that the Examiner's basis for objection to the claims should be deemed overcome, and reconsideration and withdrawal of the objection to the claims are respectfully solicited.

Claims 1 – 3 and 6 – 9 have been rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the Examiner has stated that: "Claim 1 is indefinite due to the fact that it is unclear what is actually being claimed by the phrase 'the spacing disk being formed as a single-part [sic], preferably single-unit, flange-like component.' In lines 11 – 12. It is unclear what the difference is between a 'single-part [sic]' spacing disk and a 'single-unit' spacing disk, since both of the quoted limitations infer that the element is formed as one piece. The aforementioned phrase appears as if it may be some sort of range within a range. It is

suggested that the spacing element be referred to as a 'single part' or a single-unit', but not both."

In complete response thereto, Applicant has amended claim 1 as indicated hereinabove with respect to the objection to claim 1, and respectfully submits that the Examiner's basis for rejection of the claims under 35 U.S.C. 112, second paragraph should be deemed overcome. Reconsideration and withdrawal of the rejection of the claims under 35 U.S.C. 112, second paragraph are respectfully solicited.

Claims 1 – 3 and 6 – 7 have been rejected under 35 U.S.C. 103(a) as being unpatentable over English, U.S. 3,649,079 in view of Hummel et al., U.S. 6,296,319. Claims 8 – 9 have been rejected under 35 U.S.C. 103(a) as being unpatentable over English, U.S. 3,649,079 in view of Hummel et al., U.S. 6,296,319, and further in view of Maiworm et al., U.S. 5,454,628. Applicant respectfully traverses the Examiner's substantive bases for rejection of the claims.

As an initial matter, Applicant respectfully submits that the Examiner's purported combination of the English and Hummel et al. references is improper.

Two or more references may not be combined to support an assertion of obviousness of a claimed invention absent a teaching or suggestion to their combination. Further, two or more references may not be properly combined, if to do so would frustrate the functions, goals or purposes of one or more of the respective references.

English, U.S. 3,649,079 discloses an adapter plate structure, which enables a universal mounting arrangement between a brake drum, wheel and axle assembly of a vehicle, and the wheel rim, to accommodate a variety of drum/wheel structures, having lug bolts thereabout, describing circles of different diameter. The purpose of the invention is to be able to provide an adapter to address the fact that for inventory control reasons, wheel rim makers were, at the time, making wheel rims with radially elongated bolt holes (see col. 2, lines 69 – 73), to accommodate wheels having circles of attachment bolts of different diameters. The device includes a locator plate, with alignment means (ref. no. 29), which causes the wheel rim to be centered relative to the locator plate, and thus to the brake drum/wheel structure. The bolts, which are

used to attach the rim to the wheel, are fixedly mounted to the brake drum, and extend from the drum outwardly, through the radially elongated apertures in the rim. Lug nuts 25, with washers 26, are screwed onto the free ends of bolts 16, so that washers 26 bear against the outer face of the wheel rim, to hold it against the locator plate, and, in turn, the brake drum/wheel. The inner ends of lug nuts 25 have substantial clearance from the radially inner and outer inside surfaces of the radially elongated apertures (depending upon the relative radial positioning of the bolt and the aperture), but little or no clearance on the leading or trailing circumferential inside surfaces of the radially elongated apertures. The disclosure and invention of the English '079 reference was expressly created, as an alternative to prior art constructions which involved "use of a plurality of inserts respectively associated with large lug bolt openings in the center webs of the wheels to closely fit such openings to the shanks of the lug nuts passed therethrough." Col. 1, lines 39 – 42.

The disclosure of the Hummel et al. '319 reference is directed to a fastening plate for affixing a light metal wheel rim to a vehicle brake/wheel assembly, for corrosion resistance. In this reference, bolts which hold the rim to the brake/wheel assembly, pass from the outside in, with the free ends of the bolts engaging threads in the brake cavity, or nuts affixed to the free ends of the bolts which extend into the brake cavity. The bolts which hold the rim to the brake/wheel assembly also hold the inner and outer shells of the wheel rims to each other. The bolts are received in bushes which are pressed into bores in the inner and outer wheel rim shells. The bushes are primarily provided to create a "sealing-off" effect (col. 1, lines 52 – 58).

Applicant respectfully submits that the Examiner's combination of the English and Hummel et al. references is inappropriate and was posed notwithstanding the complete absence of any teaching or suggestion in any of the references to such combination. Combining the cited references in an attempt to reconstruct Applicant's invention, with the benefit of the hindsight afforded by Applicant's own disclosure, deviates from the teachings of the cited references. Indeed, the Examiner's proposed combination goes against the express teachings of the respective references. In particular, the English reference expressly teaches against the use of liner structures in the apertures for the

lug bolts, inasmuch as the apparatus of the English reference is an express alternative to the use of such liners. Furthermore, inasmuch as the bolts of the English reference have their "free ends" in the apertures in the wheel rims, such that the lug bolts extend into the apertures in the wheel rims in order to gain purchase on the free ends of the lug bolts, Applicant submits that in such a construction, the presence of liners (or "bushes"), in the sense of those disclosed in the Hummel et al. reference, in the apertures in the wheel rims of the English reference could and likely would interfere with the proper operation of the lug nuts in fastening onto the ends of the lug bolts.

For the foregoing reasons, Applicant respectfully submits that the Examiner's proposed combination of the English and Hummel et al. references is inappropriate and against the teachings of the respective references. Therefore, Applicant respectfully submits that the Examiner's basis for rejection of claim 1 should be deemed overcome.

Even if the English and Hummel et al. references may properly be combined, which Applicant respectfully disputes, the resultant structure would fail to teach or suggest Applicant's invention of amended claim 1.

Specifically, Applicant's invention of amended claim 1 comprises a wheel for a motor vehicle made from a magnesium-containing alloy. The wheel comprises a wheel bowl unit having a central area in which attachment borings for attachment bolts as well as a hub boring are positioned, said wheel bowl unit further having a rear, ring-shaped placement area for mounting to a brake disk. The attachment borings (10), the hub boring (20), and the placement area (30) are provided with spacer units (110, 120, 130) made from an aluminum-containing alloy. The wheel further comprises a spacing tube (120), which at least partially penetrates the hub boring (20) in the axial direction. A spacing disk (130) extends in a plane perpendicular to the axial direction and is disposed against the placement area. The spacing tube (120) and the spacing disk (130) are monolithically formed together, with a conical transition section (126) connecting them.

Neither the English nor the Hummel et al. references even remotely teaches or suggests the use of a conical transition section (126), connecting a spacing tube, to be inserted into the hub aperture of a wheel rim, with an annular spacing plate, all of

which are monolithically formed together. Accordingly, Applicant respectfully submits that even if the English and Hummel et al. references were to be combined, the propriety of which combination Applicant disputes, the resulting combination would completely fail to teach or suggest Applicant's invention of amended claim 1. Therefore, Applicant respectfully submits that claim 1, as amended, patentably distinguishes over the cited prior art, and that the Examiner's substantive basis for rejection of claim 1 should be deemed overcome. Reconsideration and withdrawal of the rejection of claim 1, based upon the English and Hummel et al. references, and allowance thereof, are respectfully solicited.

Although the Maiworm et al. reference is not presently being cited against claim 1, Applicant respectfully submits that were that reference to be combined with either or both of the English or Hummel et al. references, the resulting combination still would neither teach nor suggest Applicant's invention of amended claim 1, inasmuch as the annular adapter 11 is fabricated from plastic, thus teaching away from a combination of spacing tube, conical transition section, and spacing disk, all monolithically formed together.

Inasmuch as dependent claims 2 – 3, and 6 – 9 merely serve to further define the subject matter of amended claim 1, which itself should be deemed to be allowable, claims 2 – 3 and 6 – 9 likewise should be deemed allowable. Reconsideration and withdrawal of the rejection of claims 2 – 3 and 6 – 9 are respectfully solicited.

Applicant additionally submits for the Examiner's consideration, new claims 10 and 11. Applicant submits that claim 10 patentably distinguishes over the cited prior art for the same reasons as given with respect to amended claim 1, namely that none of the prior art references, whether taken alone or in combination, teach or suggest the spacing tube (120) and the spacing disk (130) being monolithically formed together, with a conical transition section (126) connecting them. Applicant respectfully submits that claim 11 patentably distinguishes over the cited prior art in that none of the prior art references whether taken alone or in combination with one another, teaches or suggests spacing liners (110) which penetrate the attachment borings (10) in the axial direction, the spacing liners (110) including radially extending flanges which are

received against annular shoulders 136, surrounding penetrating borings (134) disposed in a face of a spacer unit (130), positioned against the placement area (30), which face is disposed opposite the wheel bowl unit.

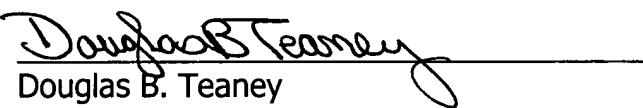
Accordingly, Applicant respectfully submits that claims 10 and 11 patentably distinguish over the cited prior art. Entry, consideration and allowance of new claims 10 and 11 are respectfully solicited.

Applicant respectfully submits that the application as a whole, including all of claims 1 – 3 and 6 – 11, is now in *prima facie* condition for allowance. Reconsideration and allowance of the application are respectfully solicited.

Should anything further be required, a telephone call to the undersigned at (312) 456-8400 is respectfully requested.

Respectfully submitted,

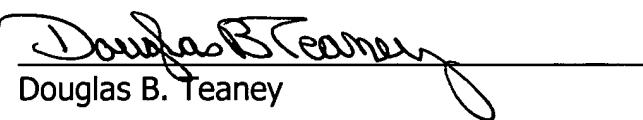
Dated: November 4, 2004



Douglas B. Teaney
One of Attorneys for Applicant

CERTIFICATE OF MAILING

I hereby certify that this AMENDMENT AND COMMUNICATION is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on November 4, 2004.



Douglas B. Teaney

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